

U.S.S.N. 09/891,014

Remarks

Applicants thank the Examiner for kindly indicating that claims 33-35 are allowable.

Regarding, the rejection of claims 30-32 under 35 U.S.C. § 112, second paragraph, the language at lines 5-9 of claim 30 indicates the amount of the recited components that are present in the microspheres, and the language at lines 13-16 of claim 30 identifies components from which the microspheres are formed. Applicants submit that claim 30 is clear as written and respectfully request withdrawal of the rejection of claims 30-32 under 35 U.S.C. § 112, second paragraph.

The Specification stands objected to under 35 U.S.C. § 112, first paragraph. Claim 22 refers to solid microspheres, which are distinguishable from hollow microspheres. Applicants' Specification incorporates by reference U.S. Patent No. 5,571,617 (the '617 patent), which describes a process of preparing solid microspheres. The skilled artisan would understand that the microspheres that result from the method of the '617 exhibit the solid property referred to in the claims. Accordingly, Applicants submit that the meaning of the term "solid" is clear and request that the objection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Regarding the rejection of claims 22 and 24 under 35 U.S.C. § 112, first paragraph, Applicants' submit that the enablement requirement is satisfied if Applicants' Specification teaches those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. *Genentech, Inc. v. Novo Nordisk*, 108 F.3d 1361, 1365 (Fed.Cir.1997). That some experimentation is required to practice the claimed invention is permissible, so long as it is not undue. *Atlas Powder Co. v. E.I. DuPont De Nemours & Co.*, 750 F.2d 1569, 1576 (Fed.Cir.1984). The microsphere adhesive prepared in Example 1 of Applicants' Specification includes solid, elastomeric microspheres. The microspheres of Example 1 are prepared with dodecane thiol, which is a chain transfer agent. In addition, Applicants' Specification discloses that chain transfer agents can be added to the polymerization mixture in an amount sufficient to provide a solvent soluble portion (see, e.g., Applicants' Specification, page 8, lines 11-29). Applicants' Specification further explains that the amount of chain transfer agent suitable for the microsphere polymerization is calculated on a weight basis to the entire

U.S.S.N. 09/891,014

polymerizable content. Thus, Applicants' Specification teaches the skilled artisan how to make the solid, elastomeric microspheres referred to in claim 22 and the skilled artisan would be able to do so without undue experimentation. Applicants submit, therefore, that the rejection of claim 22 under 35 U.S.C. § 112, first paragraph, has been overcome and request that it be withdrawn.

Regarding claim 24, Applicants' Specification explains that a vinyl-unsaturated additive may be used to improve stability and performance of the microsphere adhesive (*Id.*, page 7, lines 14-15). Applicants' Specification further discloses that the vinyl-unsaturated additive can be present in an amount from about 0.1 to about 3 parts by weight of the total polymerizable content (*Id.*, page 8, lines 7-10). Thus, Applicants' Specification explains that the vinyl-unsaturated additive is added to the polymerizable mixture used in the microsphere forming process and further provides the amount of vinyl-unsaturated additive that can be added. In addition, as set forth above, Example 1 describes a method of making solid, elastomeric microspheres using a chain transfer agent. Methods of making microsphere adhesives with a vinyl-unsaturated additive are known (see, e.g., U.S. 5,756,625, which is incorporated by reference into Applicants' Specification). Accordingly, Applicant's Specification provides the skilled artisan with the information and direction necessary to achieve the solid, elastomeric microsphere adhesive referred to in claim 24 without undue experimentation. Applicants submit, therefore, that the rejection of claim 24 under 35 U.S.C. § 112, first paragraph, is unwarranted and request that it be withdrawn.

Claims 21, 22 and 25-32 stand rejected under 35 U.S.C. § 103 over Coopridner et al.

Coopridner et al. disclose a coated sheet that includes a backing and a coating of repositionable pressure-sensitive adhesive disposed on the backing. The repositionable adhesive includes solid microspheres, polymeric stabilizer and surfactant.

Claim 21 is directed to an adhesive coated article that includes a microsphere adhesive that includes a chain transfer agent in an amount sufficient to produce 30-98 % of a solvent soluble portion in the microspheres. It is undisputed that Coopridner et al. do not teach a microsphere adhesive composition that includes a chain transfer agent.

U.S.S.N. 09/891,014

To establish a *prima facie* case of obviousness based on a single prior art reference, there must be a showing of a teaching, suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996); M.P.E.P. 2142. The suggestion or motivation to modify the reference must be found in the prior art and must not be based on Applicants' disclosure. See M.P.E.P. 2142. Here there is no such teaching, suggestion, or motivation. The Office action refers to Japanese Patent Abstract 54003136A and the Concise Encyclopedia of Polymer Science and Engineering to support the rejection of claim 21 under 35 U.S.C. § 103. It is undisputed that neither of these references teaches, suggests or provides any motivation for modifying the microsphere adhesive of Coopridner et al. to include a chain transfer agent, or including a chain transfer agent during preparation of the microspheres of Coopridner et al.

The June 9, 2003 Office action states,

[I]t is well known in the polymer adhesive art that chain transfer agents by regulating the length of the polymer chains of the particular composition control the amount of adhesiveness the resulting polymer composition exhibits. More particularly, if the adhesive chains are made shorter by the utilization of a greater amount of chain transfer agents, the adhesiveness of the composition will increase, and vice versa. Accordingly, the Examiner must respectfully submit that the utilization of such chain transfer agents in adhesive compositions to regulate the adhesion of the resulting composition is extremely well known in the art (June 9, 2003, Office Action, page 4).

Whether or not it is well known to utilize a chain transfer agent in an adhesive composition to regulate the adhesive property of the resulting composition is irrelevant to the issue of obviousness that is before us. The relevant inquiry is whether there is a suggestion or motivation in the prior art for modifying the particular microsphere adhesive of Coopridner et al. such that it is the product of a chain transfer agent (see, e.g., *B.F. Goodrich*; MPEP 2142). The finding of a suggestion or motivation in the prior art is a prerequisite to establishing a *prima facie* case of obviousness. (*Id.*) Failure to establish a suggestion or motivation constitutes a failure to establish a *prima facie* case of obviousness, which mandates withdrawal of the rejection. The Office action does not

U.S.S.N. 09/891,014

identify where the suggestion or motivation for modifying the particular compositions of Cooprider et al. in the manner proposed in the Office action can be found in the cited prior art. In other words, the Office action does not establish why the skilled artisan would decide to modify the composition of Cooprider et al. Nothing in Cooprider et al. indicates that the adhesive properties of the microspheres disclosed therein should be modified. Likewise, nothing in the general knowledge in the art suggests to the skilled artisan that the particular microsphere adhesive of Cooprider et al. should be modified --let alone that the microspheres of Cooprider et al. should be prepared from a chain transfer agent. Accordingly the skilled artisan would have no reason to modify the microspheres of Cooprider et al. in the manner proposed in the Office action. The record, therefore, fails to establish a prima facie case of obviousness of the adhesive article of claim 21. Accordingly, Applicants submit that the rejection of claim 21 under 35 U.S.C. § 103 over Cooprider et al. cannot stand and must be withdrawn.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103 over Cooprider et al. in view of Le Fevre. Claim 23 and 24 depend from claim 21. The secondary reference of Le Fevre fails to cure the deficiencies of Cooprider et al. as set forth above with respect to claim 21. Accordingly, Applicants submit that the rejection of claims 23 and 24 under 35 U.S.C. § 103 over Cooprider et al. in view of Le Fevre is unwarranted for at least the same reasons set forth above in distinguishing claim 21 and request that the rejection be withdrawn.

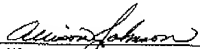
The claims now pending in the application are in condition for allowance and such action is respectfully requested. The Examiner is invited to telephone the undersigned should a teleconference interview facilitate prosecution of this application.

U.S.S.N. 09/891,014

Please charge any additional fees owing or credit any over payments made to
Deposit Account No. 501,171.

Respectfully submitted,

Date: September 9, 2003


Allison Johnson
Reg. No. 36,173

Allison Johnson, P.A.
6016 Logan Ave. S.
Minneapolis, MN 55419
Telephone (612) 861-8621
Facsimile (612) 861-8628